

REMARKS

In a final office action dated December 21, 2004, the Examiner rejected claims 1, 2, 4-6, 8, 9, 11-13, 15, 16 and 18-20 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement¹, rejected claims 1-4, 6, 8-11, 13, 15-18 and 20 under 35 U.S.C. §103(a) as obvious over Cierniak, et al., “Briki: an Optimizing Java Compiler” in view of Hastings (US Patent 5,835,701), and rejected claims 5, 12 and 19 under 35 U.S.C. §103(a) as obvious over *Cierniak* and *Hastings*, and further in view of Wolczko, et al. (US Patent 6,115,782). Claims 7, 14 and 21 were allowed. Applicants subsequently submitted an amendment dated February 21, 2005, amending certain claims and traversing certain rejections. By advisory action dated March 28, 2005, the Examiner indicated that the amendment would not be entered because it raises new issues and is not deemed to place the application in better form for appeal or simplify issues. Applicants submit the present amendment (the second after final rejection) in response to the advisory action and the original final office action.

Applicants have cancelled rejected claims 1, 8 and 15, and the rejections thereof are moot.

Dependent claims 2, 9 and 16 have been amended to change their dependency, so that they now depend from allowed claims 7, 14 and 21, respectively. Because they now depend from allowed claims, the rejections of claims 2, 9 and 16 on prior art grounds have now been overcome. Furthermore, while these claims were rejected on enablement grounds, this rejection

¹ In the office action, at paragraph 3, the Examiner rejects “claims 1-6, 8-13 and 15-20” on these grounds. However, claims 3, 10 and 17 are verbatim recitations of the original claims 3, 10 and 17, re-written in independent form. These claims do not contain the recitations of “digital data objects” and “digital data processing device” objected to by the Examiner. Since the grounds of objection do not apply to claims 3, 10 and 17, and no grounds were offered for these claims, it is assumed that the inclusion of claims 3, 10 and 17 in the list of claims rejected under 35 USC 112 was an unintentional error.

was based solely on matter recited in the independent claims from which they depended. Since claims 2, 9 and 16 no longer depend from rejected claims 1, 8 and 15, and therefore no longer incorporate the objectionable matter, the enablement rejection of these claims is likewise overcome.

Dependent claims 3, 10, and 17 have been amended to restore them to their original form at filing, i.e., as dependent claims dependent on claims 2, 9 and 16, respectively. These amended claims are now patentable for the reasons stated above with respect to claims 2, 9 and 16.

Dependent claims 4-6, 11-13, and 18-20 are unamended. These claims depend from claims 2, 9 and 16, respectively, and in view of the amendments to the base claims from which they depend, are patentable for the reasons noted above.

In view of the foregoing, applicants submit that the claims are now in condition for allowance and respectfully request reconsideration and allowance of all claims. In addition, the Examiner is encouraged to contact applicants' attorney by telephone if there are outstanding issues left to be resolved to place this case in condition for allowance.

Respectfully submitted,

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